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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 09/836,163  | 04/18/2001  | William Simpson-Young | 169.2020            | 7407             |
| 5514  | 7590        | 06/24/2005            | EXAMINER            |                  |
| FITZPATRICK CELLA HARPER & SCINTO<br>30 ROCKEFELLER PLAZA<br>NEW YORK, NY 10112 |             |                       |                     | LIN, WEN TAI     |
| ART UNIT  |             | PAPER NUMBER          |                     |                  |
| 2154  |             |                       |                     |                  |

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                         |                      |
|------------------------------|-------------------------|----------------------|
| <b>Office Action Summary</b> | Application No.         | Applicant(s)         |
|                              | 09/836,163              | SIMPSON-YOUNG ET AL. |
|                              | Examiner<br>Wen-Tai Lin | Art Unit<br>2154     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 April 2005.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 and 37-40 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-17 and 37-40 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 1-17 and 37-40 are presented for examination. Claims 18-36 have been canceled and claims 38-40 are newly added.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

***Claim Rejections - 35 USC § 112***

3. Claims 7-8, 13-16 and 37 are rejected under 35 U.S.C. 112 because the following terms lack antecedent basis:
  - In claim 7, "said linked entity pairs";
  - In claim 13, "said desired communication";
  - In claim 13, "said originating device";
  - In claim 13, "said target device"; and
  - In claim 37, "said linked entity pairs".
4. Claims 12 is objected to because the equating of the extended markup language (xml) to the messaging protocol is confusing. It is noted that a message may be presented in xml format but the format itself is not the message protocol that governs

how the message is sent. It's just like an HTML (a presentation format or language) has been used in HTTP protocol, but the HMTL and HTTP are two different things.

***Claim Rejections - 35 USC § 102***

5. Claims 1-11, 13-15, 17 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Giese et al. (hereafter "Giese") [U.S. Pat. No. 6728267].
6. As to claim 1, Giese teaches the invention as claimed including: a method of automatically establishing a desired communication between an originating device and a target device, said originating device and said target device each having an associated profile [col.16, lines 1-43], said method comprising steps of:
  - (i) determining a profile compatibility between said originating device and said target device [Figs.16-17; col.15, lines 47-52];
  - (ii) establishing said desired communication, if a direct profile compatibility between said originating device and said target device is found, said establishing being directly between said originating device and said target device [e.g., terminals 88 and 86 of Fig.18 lie within the same network and are capable of communicating with the same voice format can be linked directly]; and
  - (iii) establishing said desired communication, if said direct profile compatibility between said originating device and said target device is not found, said establishing being indirectly between said originating device and said target device by incorporating

at least one additional device [e.g., a gateway], said at least one additional device having an associated profile, said incorporation forming linked device pairs among said originating device, said target device and said at least one additional device, wherein said incorporation establishes a direct profile compatibility between each said linked pair of said devices [e.g., terminals such as 88 and 92 of Fig.18 reside in different network require communication channel established via a gateway (e.g., 98, Fig. 18)]; and each of the steps (i), (ii) and (iii) is performed by at least one of the originating device, the target device, and the at least one additional device [note that for the case when two devices are able to communicate directly, for example as peer-to-peer communication or direct link, it is inherent that steps (i) and (ii) would be performed by the two parties involved; while in the case when an intermediate device such as a gateway device has to be involved (because of incompatibility between the two end parties), it is inherent that step (iii) would be performed by the intermediate device].

7. As to claims 2-3, Giese further teaches that said incorporating comprises steps of:

(a) communicating, by one of said originating device [e.g., 88, Fig.18] and said target device [e.g. any terminal residing in the ATM or TDM networks of Fig.18], to a first additional device [e.g., 98, Fig.2], thereby forming linked device pairs among said originating device, said target device and said at least one additional device;

(b) establishing said desired communication, if direct profile compatibility is established between each said linked pair of devices [e.g., devices 88 and a terminal with the ATM network can be established with a gateway];

(c) communicating, by one of said originating device, said target device and said first additional device, if said direct profile compatibility is not established between each said linked pair of devices, to a second additional device, thereby forming linked device pairs among said originating device, said target device, said first additional device and said second additional devices [e.g., connection between 88 and 90 is established via a first and a second gateway via bridge 92 (see also col.16, line 1 –col.17, line 12)]; and

(d) repeating steps (b) and (c) until said desired communication is established, said direct profile compatibility being established between each linked pair of devices [col.17, lines 13 – 20; i.e., the illustrated example can be repeatedly applied to a larger WAN].

8. As to claim 4, Giese further teaches that each said device comprises one of a device or a service [i.e., the gateways or bridges are devices but may also be viewed as services].

9. As to claims 5-9, since the features of these claims can also be found in claims 1-4, they are rejected for the same reasons set forth in the rejection of claims 1-4 above.

10. As to claim 11, Giese further teaches that said message comprises at least one of a command and a data value [col.9, lines 35-39].

11. As to claims 10, 13-15, 17 and 37-39, since the features of these claims can also be found in claims 1-9 and 11, they are rejected for the same reasons set forth in the rejection of claims 1-9 and 11 above.

As for the additional limitation in claim 10 requiring that said communicating (for forming the linked device pairs) does not require understanding by said communicating device of said message: it is noted that Giese teaches such feature at col.3, lines 6-10.

As for the additional limitation in claim 10 requiring the communication system to comprise means for searching said network to identify an intermediate service having a profile compatibility with said service and by which intermediate functional communications between said service and said intermediate service can be established: it is noted that Giese teaches such feature at col.4, lines 16-19; col.7, lines 24-29.

12. As to claim 40, Giese teaches a requesting means for requesting the at least one additional device for format conversion of data from the target device, wherein said second establishing means established the communication to receive the converted data from the at least one additional device [col.10, lines 20-33; col.16, line 64- col.17, line 12].

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giese et al.(hereafter "Giese ;")[U.S. Pat. No. 6728267], as applied to claims 1-11, 13-15 and 37 above, further in view of Zintel; [U.S. Pat. No. 6779004].

15. As to claims 12 and 16, Giese does not specifically teach that said messaging protocol is the Extended Markup Language (XML).

However, in the same field of endeavor Zintel; teaches that XML can be used as messaging protocol [Zintel;: col.2, line 64 – col.3, line 8].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form Giese ;'s messages in XML because it is well known that XML supports structured information with designated tags that can be used for extracting command and its associated parameters that are embedded in Giese ;'s message.

16. Applicant's arguments filed on 4/13/2005 for claims 1-17 and 37 have been fully considered but they are not deemed to be persuasive.

17. Applicant argues in the remarks that: Giese's communication is established and maintained by one or more centralized entities, while in contrast, Applicant's desired communication is established directly between the originating and the target devices (if a direct profile compatibility is found).

18. The examiner respectfully disagrees with applicant's remarks. First, the claimed feature of "automatically establishing a desired communication between an originating device and a target device" is found in the preamble, which is weakened by step (iii) because it requires involvement of an additional device when no direct profile compatibility between the originating and target devices is found. Secondly, the claim language does not preclude a centralized servicing device from acting as the additional device. As a matter of fact, Giese's system covers both scenarios: For compatible devices residing within the same network, direct communication can always be made without services provider's involvement [note that this is an inherent feature for any compatible device pair residing within the same network. Further, Giese's teaching goes beyond the compatible device pair when inter-network communication or incompatible functionality involves, that is, by way of intermediate devices such as bridge, gateway, or brokerage services. Since Applicant's claim language does not

preclude these types of intermediate devices from being “the additional device”, it is submitted that Giese reads on the claims.

19. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

June 20, 2005

*Wen-Tai Lin*  
6/20/05